Appln. No.: 10/693,666
Amendment dated October 19, 2005
Reply to Office Action of July 19, 2005

REMARKS/ARGUMENTS

The office action of July 19, 2005, has been carefully reviewed and these remarks are responsive thereto. Claims 1-10, 19 and 22 have been amended. No new matter has been added. Claims 1-25 thus remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

Rejections Under 35 U.S.C. § 101

Claim 1 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. While Applicants disagree with the characterization of the claims, as the rejection cites no valid case law supporting such a rejection, Applicant has amended claims 1-10 and respectfully requests the rejection be withdrawn.

Rejections Under 35 U.S.C. § 102

Claims 1-3, 7-8, 10-13, 15-16, 18-21, 23-25, and 27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Mander *et al.* (U.S. Pat. No. 6,243,724, hereinafter Mander). Applicants respectfully traverse this rejection for at least the following reasons.

In order to reject a claim as anticipated under 35 U.S.C. §102, a single prior art reference must teach every aspect of the claimed invention. MPEP § 706.02. However, Mander fails to satisfy this requirement. For example, amended independent claim 1 recites, *inter alia,* "adding an item to the list by generating a list entry representing an association between an item and the item type, wherein the list entry comprises one or more item properties specified by the relationship type." Mander does not teach or suggest generating a list entry wherein the list entry comprises one or more item properties specified by the relationship type. At most, Mander discloses information associated with a document such as data type, date and source. Col. 20, lines 56-67. In fact, Mander lacks any teaching or suggestion of relationship types, much less generating a list entry representing an association between an item and the item type, wherein the list entry comprises one or more item properties specified by a relationship type. Claim 1 is thus allowable for at least this reason.

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Claims 2-3, 7-8 and 10 are dependent on claim 1 and are thus allowable for at least the same reasons as claim 1 and further in view of the novel and non-obvious features recited therein.

Amended independent claim 11 recites, *inter alia*, "a processing unit for operating a process to generate a list of selected items in response to a user input...wherein each entry includes a property value generated in accordance with the list entry template." The Office Action at page 5 asserts that Mander discloses user input to operate a process to create a collection or pile of documents. Even assuming, without admitting, the validity of this assertion, Mander still does not teach or suggest a list entry template, much less a property value generated in accordance with the list entry template. More specifically, Applicants' specification at page 3, paragraph [0041] states that the list entry template specifies property names for a set of properties defined by the list entry relationship type. Mander, on the other hand, merely describes at col. 9, lines 30-48 the process for creating a pile of documents by modifying pathnames or providing an empty base for which to create a new pile. Nowhere does Mander teach or suggest a list of selected items, wherein each entry includes a property value generated in accordance with a list entry template. Claim 11 is thus allowable for at least this reason.

Claims 12-13, 14-16 and 18 are dependent on claim 11 and are thus allowable for at least the same reasons as claim 11 and further in view of the novel and non-obvious claims recited therein.

Amended independent claim 19 recites, *inter alia*, "adding an item to the list by generating a list entry representing an association between an item and the item type, wherein the list entry comprises one or more item properties specified by the relationship type." As discussed above with respect to claim 1, Mander does not teach or suggest such a feature. Claim 19 is thus allowable for at least this reason.

Claims 20-21, 23-25 and 27 are dependent on claim 19 and are thus allowable for at least the same reasons as claim 19 and further in view of the novel and non-obvious features recited therein.

Rejections Under 35 U.S.C. § 103

Claims 4-6, 9, 14, 17, 22, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mander in view of Chao *et al.* (U.S. Publ. Appl. No. 2002/0169678 A1, hereinafter Chao).

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

However, there is no motivation or suggestion to combine Mander with Chao. The Office Action states that it would have been obvious to combine the references to "enable a user with alternative ways to access and manage the list of item or documents that are displayed on the display screen with operations such as viewing, deleting, adding, copying, removing and updating." This is not a motivation to combine references, however, but rather is the conclusion the examiner has apparently reached after having benefited from reading Applicant's own disclosure, and is thus impermissible hindsight.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Thus, Applicants respectfully submit that that there is no motivation or suggestion to combine Mander, which discloses a method for organizing electronic documents and information in a computer filing system, with Chao, which discloses a method for managing and representing hierarchical entities and relationships. More specifically, Chao relates to the modeling of relationships between business entities. p. 11, paragraph [0156] – p. 12, paragraph [0162]. Mander, on the other hand, relates to the organization of electronic documents and information in a computer filing system. *See* Abstract. Significantly, nowhere does Chao teach or suggest managing a list of items or documents, much less alternative ways to

do so. At most, Chao discloses at p. 11, paragraph [0152] a method for maintaining a list of known relationship types. As such, the methods disclosed in Chao are wholly unrelated to the creation and management of a list of electronic documents and/or data, and one of ordinary skill in the art would not have been motivated to combine these contrasting technologies.

Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, as is often argued by the Office, the Office Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Office Action provide any evidence that the combination does not include knowledge gleaned only from Applicant's disclosure. Thus, the combination is an improper combination based on hindsight.

Additionally, amended independent claim 1 recites, *inter alia*, "adding an item to the list by generating a list entry representing an association between an item and the item type, wherein the list entry comprises one or more item properties specified by the relationship type." Even assuming, without admitting, that the combination of Mander and Chao is proper, the combination still fails to teach or suggest all of the features of claim 1. As discussed above with respect to claim 1, Mander does not teach or suggest a list entry comprising one or more *item* properties specified by a relationship type. Chao fails to cure this deficiency. Chao, at page 12, paragraph [0162], discloses relationships and relationship type-specific extra data in an organization hierarchy. More specifically, Chao discloses relationship type-specific data of the *relationship* between two entities but not relationship type specific properties of the *entities or items* themselves. Thus, Chao fails to teach or suggest a list entry comprising one or more item properties specified by the relationship type. Claims 4-6 and 9 are dependent on claim 1 and are thus allowable for at least this reason.

Independent claim 11 recites, *inter alia*, "a processing unit for operating a process to generate a list of selected items in response to user input...wherein each entry includes a property value generated in accordance with the *list entry template*." (emphasis added). As discussed previously, Mander does not teach or suggest such a feature. Chao also does not teach

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or suggest such a feature. Claims 14 and 17 are dependent on claim 11 and are thus allowable for at least this reason.

Amended independent claim 19 recites, *inter alia*, "adding an item to the list by generating a list entry representing an association between an item and the item type, wherein the list entry comprises one or more item properties specified by the relationship type." For substantially the same reasons as presented with respect to claim 1, neither Mander nor Chao teach or suggest this feature of claim 19. As such, claims 22 and 26, dependent on claim 19, are allowable for at least this reason.

CONCLUSION

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

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